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09/711,194	11/13/2000	Casey William Norman	1391-CIP-00	6427

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IP DEPARTMENT OF PIPER RUDNICK LLP  
ONE LIBERTY PLACE, SUITE 4900  
1650 MARKET ST  
PHILADELPHIA, PA 19103

EXAMINER

WILLIAMS, JAMILA O

ART UNIT PAPER NUMBER

3722

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/711,194

Applicant(s)

NORMAN ET AL.

Examiner

Jamila O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 8/5/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-16,18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,3-18, 20,21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23,25-51 of copending Application No. 09/844322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in scope and subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3-5,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda. Yasuda discloses a seamless doll's skin or garment (fig 1) comprising a seamless, molded elastomeric material (column 3 lines 18-54 of the specification) adapted to be repeatedly dressed, fitted over and removed from a doll to transform the doll into a different character or object (inherently capable of this function) and flexible to bend at bending locations of the doll; wherein the elastomeric material is a synthetic polymer, which is a copolymer consisting ethylene-vinyl acetate copolymer (column 3 lines 24-25).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-11,13-14,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda. Yasuda discloses all of the elements of the claims except for the modulus of elasticity, as recited in claims 6,13,14,21 and the adaptability of the garment to be used with dolls of a specific height range, as recited in claims 7-8,10 and form as recited in claim 9. In that the material of Yasuda is elastomeric, it inherently has a modulus of elasticity. It would have been obvious to one having ordinary skill in the art to construct the material of Yasuda to have the claimed modulus of elasticity for the purpose of providing better elastic properties or flexibility

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of the material. Regarding the limitation that the garment or skin is adapted to be used with a doll having a specific height range. It is old and well known to make dolls of various heights and sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material of Yasuda usable with dolls of varying height ranges. Regarding the skin having a specific form as recited in claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda to form an animal since the material is disclosed to be used as fur of stuffed animal toys (column 19 lines 62).

7. Regarding the limitations of claims 13 where the applicant is claiming both a doll's skin and garment. It appears from the specification (page 4 line 20) that "the garment is a skin". Therefore the examiner maintains that Yasuda meets the requirements of the claim as stated above.
8. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of '774 to Fogarty. Yasuda discloses all of the elements of the claims as applied to claim 11 above. Yasuda does not, however, disclose the garment having at least one integrally molded detail. Fogarty teaches molded doll garments having integrally molded details (fig 4, 9). It would have been obvious to use the teaching of an integrally molded feature of Fogarty with the garments (doll clothes) of Yasuda for the purpose of making the garment more realistic.
9. Claims 1, 3-5, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses all of the elements of the

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claims including molded elastomeric material used as a doll's skin, and the skin having the form of a cartoon character (cowgirl, princess). Fogarty does not however disclose the specifics of the material as recited in claims 3-5. Yasuda provides a teaching for a synthetic polymer which is a copolymer consisting of ethylene-vinyl acetate copolymer (column 3 lines 24-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda with the skin of Fogarty for the purpose of providing more flexibility.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over '774 to Fogarty in view of Yasuda. Fogarty discloses a play set including a doll donned and fitted with a flexible plastic garment which removably encloses around at least a part of the doll and is adapted to be removed, dressed and refitted again to the doll (fig 9-13). Fogarty does not however specifically provide a teaching of a synthetic polymer for the garment nor the height range for the doll. Yasuda discloses a material used for doll clothes (garments) including a synthetic polymer (column 3 lines 18-25 of the specification). It would have been obvious to use the material of Yasuda with the garments of Fogarty for the purpose of providing more flexibility. Regarding the height range of the dolls. It is old and well known to make dolls of different heights and sizes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the height of the doll as a matter of design choice and for the purpose of providing a more reasonably sized doll for different users.

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11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '774

to Fogarty in view of Yasuda and further in view of Gross. Fogarty and Yasuda disclose all of the elements of the claims as recited above. However a doll articulated at a joint, as recited in claim 16 is not disclosed. Gross teaches a doll articulated at the elbow and knee (see fig 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the joints of Gross with the doll and garments of Fogarty and Yasuda for the purpose of proving a more realistic play set for the user.

7. Claims 1,7,8,10,15,16,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian et al, hereinafter O'Brian and either Gross or Wion.

Kramer discloses a doll, a doll's skin or garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M ) and the doll's skin or garment has a size and shape to approximate the size and shape of at least a portion of the doll.

Kramer does not disclose an elastic injection molded thermoplastic elastomer doll's skin or garment and doll having articulated limbs as recited in claim 1, 15; the garment is sized to be fitted to and removed from a doll less than 8 cm in height as recited in claim 7 and a play set comprising a doll wherein the doll is articulated at a

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joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips as recited in claims 15,16.

O'Brian ( Figs 2 and 3) teaches the concept of providing an elastic injection molded thermoplastic elastomer doll's skin or garment (col 4 line 58 and col 3 lines 54-56), see also the definition of resilient- capable of returning to an original shape or position, as after having been compressed, Merian-Webster's Collegiate Dictionary 10th ed) and (col 3 lines 54-56)]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's skin or garment of Kramer for aesthetic reasons and to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more enjoyable for the children to play with.

With respect to claim 7,8,10 and 15, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

12. Claims 3,4,5,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kramer in view of O'Brian and either Gross or Wion as applied to claims above and further in view of Yasuda.



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Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material claimed.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54), in order to make clothes for dolls. It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**DERRIS H. BANKS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

jw

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